REMARKS

This Response is responsive to the Examiner's Non-Final Office Action Summary mailed August 25, 2003. In the Office Action Summary, the Examiner rejects claims 1-13 pending in the application, and allows claim 14. In response, the Applicants amend claim 12 and present arguments of patentability regarding the remaining pending claims (claims 1-12, and 14). After entry of the following remarks, claims 1-12 and 14 (3 independent; 13 total claims) remain pending in the application. Applicants respectfully disagree with the Examiner's assertions regarding the patentability of the pending claims, and therefore traverse the same. Applicants respectfully request reconsideration of the application in view of the following remarks.

35 U.S.C. § 102(b) Rejection – Claims 1, 3-8 and 10-13

Claims 1, 3-8 and 10-13 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,018,690 issued January 25, 2000, to Saito et al. (the "Saito" patent). In particular, the Examiner notes that Saito discloses all the elements of Applicants' independent claims 1 and 12, and the elements of the claims depending therefrom. Applicants respectfully disagree with the Examiner's contentions and therefore traverse the Examiner's rejection.

As a preliminary matter, Applicants note that to anticipate a claim, the reference must teach every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987). The identical invention must be shown in as complete a detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Applicants assert that the Saito reference cited by the Examiner does not anticipate Applicants' claims, since Saito does not show every element of Applicants' invention in as complete detail as is contained in Applicants' claims.

With regard to Applicants' independent claims 1, Applicants note that claim 1 recites that "the power control apparatus receives the plurality of first power request signals respectively from the plurality of electric products, generates a second power request signal for requesting an amount of power which is determined in accordance with a total amount of power requested by the plurality of first power request signals, and outputs the second power request signal to the power generation apparatus" and that "the power generation apparatus increases or decreases the amount of power generation so as to match the amount of power generation with a target amount of power generation which is determined in accordance with the second power request signal."

One advantage of Applicants' claimed arrangement is that the recitations allow the power supply system of Applicants' invention to control the amount of power generated by the power generation apparatus so that the power generation apparatus can generate a "necessary amount" of power "when necessary" in response to the second power request signal which is determined based on the first power request signals from the plurality of electric products. As a result, the amount of power generated by the power generation apparatus is not increased more than the "necessary amount," thereby reducing the power consumption.

On the other hand, Saito fails to teach, suggest or disclose the limitations of Applicants' claim 1. While the system of Saito teaches that the breaker apparatus 101 manages and controls the power consumption of all electric apparatuses based on the power use request message from the electric apparatus which needs to consume power of a desired value, the purpose of the Saito system is merely to prevent so-called switching-off of the circuit breaker by permitting or rejecting the power use request message so that the consumed power may not exceed a predetermined upper limit. In addition, although the power generation apparatus of Saito is the electric power company which sends power to the external power line 107, there is no teaching or suggestion in Saito of the power consumption controller 306 sending a second power request signal to the electric power company. More specifically, the description of column 9, lines 38-50 of Saito discloses that "when the electric apparatus needs to consume power of a desired value, the power use request message is transmitted to the breaker apparatus 101 to request use of power. The breaker apparatus 101, which manages and controls the power consumption of all electric apparatuses connected to the power line 102, permits or rejects the power use request message." Thus, Saito does not teach, suggest or disclose, *inter alia*, that the power generation apparatus increases or decreases the amount of power generation so as to match the amount of power generation with a target amount of power generation which is determined in accordance with a second power request signal, as is claimed by the Applicants. More succinctly, Saito does not disclose the identical power generation apparatus in complete a detail as is shown in Applicants' claim 1.

The Examiner asserts that the description of column 2, lines 56-60 discloses the "power generation apparatus" as claimed by Applicants. However, Applicants respectfully disagree with this characterization of Saito, since Saito is directed to a "breaker apparatus" for controlling the power consumption so that the consumed power may not exceed a predetermined upper limit.

That is, the Saito invention is not directed to any "power generation apparatus" capable of varying an amount of power generation. Further, the Examiner asserts that the descriptions of column 7, lines 30-41 and column 9, lines 38-50 discloses "increasing or decreasing the amount of power generation so as to match the amount of power generation with a target amount of power generation which is determined in accordance with the second power request signal" as claimed. Again, Applicants respectfully disagree with the Examiner's characterization of Saito, since Saito merely discloses "power consumption controller 306 determines whether the use of power is permitted, on the basis of the data on the present power consumption of the electric apparatus" (column 7, lines 30-40) and thereby preventing so-called switching-off of the circuit breaker by permitting or rejecting the power use request message so that the consumed power may not exceed a predetermined upper limit (column 9, lines 38-50).

As mentioned above, Saito does not disclose a "power generation apparatus" as claimed by the Applicants. Indeed, Saito cannot provide the power system of Applicants' invention, which reduces the power consumption as recited in claim 1, since Saito is directed to a breaker apparatus for controlling the power consumption so that the consumed power may not exceed a predetermined upper limit, which solves the problem relating to the breaker apparatus. That is, as can be seen by a thorough reading, Saito provides a breaker apparatus for controlling power consumption, but Saito does not provide a power supply system for reducing the power consumption as recited in Applicants' claim 1. Thus, Saito does not teach, suggest, or disclose all the elements of Applicants' claim 1 in sufficient detail to support a proper section 102 rejection of that claim, and claim 1 is therefore allowable over the Saito reference.

Moreover, Applicants note that it is possible to provide a breaker apparatus described in Saito in the power supply system as recited in Applicants' claim 1, in order to prevent so-called switching-off of the circuit breaker. As such, Applicants respectfully assert that the subject matter of Saito is directed toward a different invention than is claimed by Applicants.

35 U.S.C. § 102(b) Rejection – Claims 3-8 and 10-13

Applicants cancel claim 13 without prejudice. Thus, the Examiner's rejection of claim 13 is now rendered moot.

As noted with respect to claim 1, Saito does not teach, suggest or disclose a power generation apparatus, as claimed by Applicants. Namely, Saito does not teach, suggest or disclose a power generation apparatus capable of varying an amount of power generation, as

recited in Applicants' claim 1. Thus, Saito does not teach, suggest, or disclose all the elements of Applicants' claim 1 in sufficient detail to support a proper section 102 rejection of that claim, and claim 1 is therefore allowable over the Saito reference. In addition, since claims 2-11 variously depend from allowable claim 1 and incorporate the claim 1 elements, then claims 2-11 (including claims 3-8 and 10) are also allowable over the Saito reference.

In addition to the above, Applicants amend claim 12 to include the limitations of claim 13 and limitations included in claim 1. Particularly, claim 12 is amended to recite, *inter alia*, that the terminal is connected to a power supply system, the power supply system includes a plurality of electric products, a power generation apparatus capable of varying an amount of power generation, and a power control apparatus for controlling power supply from the power generation apparatus to the plurality of electric products, and the power control apparatus outputs a power request signal to the power generation apparatus. As such, in accordance with the remarks set forth herein regarding Applicants' claim 1, Applicants' amended claim 12 is now allowable over the Saito reference. More particularly, as noted, Saito does not teach, suggest or disclose, *inter alia*, a power generation apparatus capable of varying an amount of power generation, as recited in Applicants' claim 12. Thus, Saito does not teach, suggest, or disclose all the elements of Applicants' claim 12 in sufficient detail to support a proper section 102 rejection of that claim, and claim 1 is therefore allowable over the Saito reference.

In accordance with the above arguments, Applicants therefore respectfully request that the Examiner's section 102(b) rejection of Applicants' claims 1, 3-8, and 10-13 be withdrawn.

Claim Rejections -35 U.S.C. §103(a)-Claims 2 and 9

The Examiner rejects claims 2 and 9 under 35 U.S.C. §103(a) as being unpatentable over Saito as applied to claims 1 and 6, in further view of U.S. Patent No. 6,219,623, issued April 17, 2001, to Wills ("Wills"). In particular, the Examiner suggests that while Saito does not expressly disclose the use of a fuel cell or a storage cell for power generation, Wills discloses a power supply system wherein the power generation apparatus is a fuel cell and a power supply source wherein the power supply source is a storage cell. The Examiner asserts that at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use a fuel cell and a battery for Saito's power supply control system. The Examiner contends that one of ordinary skill in the art would have been motivated to do this since they are independent

power sources and can generate power that can be sold. Applicants respectfully disagree with the Examiner's contentions and therefore traverse the same.

Applicants note that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

Applicants also note that the level of skill in the art cannot be relied upon to provide a suggestion to combine the references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). Where the references relied upon teach that all aspects of the claimed invention were individually known in the art, the teachings are not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Furthermore, Applicants note that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. That is, although a reference may be modified to run the way the apparatus is claimed, there must be some suggestion or motivation in the reference to do so. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

In accordance with the above remarks, Applicants respectfully assert that Applicants' invention would not have been obvious to one skilled in the art at the time the invention was made since the combination of Saito and Wills does not teach, suggest or disclose all the elements of Applicants' invention. As noted, Saito does not disclose, teach or suggest a power generation apparatus as is claimed in Applicants independent claim 1. As such, Applicants respectfully assert that Saito cannot support a proper section 103 rejection of Applicants' independent claim 1, and Applicants' claim 1 is allowable over the Saito-Wills combination. Further, since claims 2 and 9 variously depend from Applicants' allowable claim 1, then claims 2 and 9 are also allowable. As such, Applicants respectfully request that the Examiner's section 103 rejection of Applicants' claims 2 and 9 be withdrawn.

In addition to the above, Applicants note that the Examiner suggests that the motivation for combining the Saito and Wills references is that the fuel cell and battery are independent

Respectfully submitted,

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